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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,755	07/31/2001	Toshihiro Kodaka	1095.1190	2798
21171 7590 02/23/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/917,755

Applicant(s)

KODAKA ET AL.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/02/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-16 have been examined. Application 09/917,755 (Method of and apparatus for distributing advertisement) has a filing date 07/31/2001 and foreign priority 03/21/2001.

### ***Response to Amendment***

2. In response to Final Rejection filed 05/31/2006, the Applicant filed an RCE on 11/30/2006, which added new claim 16.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 recites in line 6 "storing an identifier transmitted from said coupon management server". Said limitation is indefinite because it does not explain where said identifier is stored and is not clear what item said identifier identifies. Claim 13 recites "acquiring second contents including a list of commodities to which types of second coupon information defining a benefit upon the purchase of the commodities are related, via said network; transmitting said types of second coupon information related to the list of commodities included in said second contents and said identifier to said coupon management server to acquire usable coupon information from said coupon management server and displaying said second contents and said usable coupon

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information. Said limitation is indefinite because it is not clear how second coupon information is acquired but then is different from usable coupon information.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 5, 6, 12 and 14-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Hymel (US 6,114,969).

As per claims 1, 12, 14 and 15, Hymel teaches:

A method of distributing an advertisement with a computer over a network, comprising the steps of:

managing coupon information which defines a benefit upon purchase of a given commodity and advertisement information in association with said coupon information (see col 1, lines 40-50; col 4, lines 10-25), and

transmitting said advertisement information to a terminal, which is connected via said network in response to a request from said terminal (see col 5, lines 40-55);

and, as immediate consequence of said transmitting storing said coupon information associated with said advertisement information transmitted to said terminal, in association with said terminal (see col 4, lines 10-25; col 5, lines 35-55);

referring to said coupon information stored in association with said terminal and determining a benefit upon purchase of the given commodity in response to a benefit

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inquiry request for said given commodity from said terminal and indicating the determined benefit to said terminal (see col 7, lines 15-50).

As per claim 2, Hymel teaches:

A method according to claim 1, wherein the benefit defined by said coupon information represent a discount to be offered upon purchase of the given commodity (see col 1, lines 45-50; col 7, lines 15-30).

As per claim 3, Hymel teaches:

A method according to claim 2, wherein said coupon information represents a discount amount to be offered upon purchase of the given commodity (see col 1, lines 45-50).

As per claim 5, Hymel teaches:

A method according to claim 1, wherein said coupon information represents an expiry date and can be used only prior to said expiry date (see col 7, lines 15-30).

As per claim 6, Hymel teaches:

A method according to claim 5, wherein said coupon information represents a period after which a user is able to use a coupon actually after the user has acquired the coupon (see col 7, lines 15-30).

As per claim 16, Hymel teaches:

A method of distributing advertisement information over a network, comprising:  
storing coupon information pertaining to an advertisement responsive to transmission of the advertisement to a requesting terminal (see col 5, lines 40-55); and

associating the coupon information with said terminal and referring to the coupon information for determining a benefit thereof in response to an inquiry from the terminal (see col 7, lines 15-50).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hymel (US 6,114,969).

As per claim 4, Hymel does not expressly teach:

A method according to claim 2, wherein said coupon information represents a discount rate to be offered upon purchase of the given commodity. However, Official Notice is taken that it is old and well known in the promotion art to offer coupons based upon a percentage off of a product. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hymel's coupons would be based upon percentage off of products, as it is old and well know to do so.

6. Claims 7-10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hymel (US 6,114,969) in view of Leonard (US 2002/0046109) and further in view of Kargman (US 2002/0049644).

As per claim 7, Hymel teaches:

A method according to claim 1, further comprising the steps of:

referring to said coupon information stored in association with said terminal and determining a benefit upon purchase of the given commodity in response to an application for the purchase of the given commodity from said terminal (see col 7, lines 15-50) but fails to teach and producing a sales contract for the given commodity with the determined benefit applied, and settling the purchase of the given commodity based on the sales contract. However, Leonard teaches a system where electronic coupons are stored in users' terminals and where said coupons are automatically applied to qualifying online purchase (see Leonard paragraph 105). Kargman teaches that it is old and well known in the communication art to order products via the Internet using web-enabled mobile devices (see Kargman paragraph 47). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hymel would be motivated to automatically applied to a qualifying online purchase an electronic coupon stored in a user's mobile device, as taught by Leonard, where said mobile device would be web-enabled, as taught by Kargman in order to lure consumers to purchase products related to said coupons.

As per claim 8, Hymel fails to teach:

A method according to claim 7, wherein the purchase of the given commodity is settled by asking a banking organization server which can withdraw money from an account of the user of said terminal, to withdraw an amount of money based on the sales contract from the account of the user of said terminal. However, Leonard teaches a system that identifies stored coupon in a user's terminal when said user is registering an online purchase and based upon said identification, said system automatically

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applied said stored electronic coupon to said purchase and performs a settlement transaction (see Leonard paragraph 105; 54-60). Kargman teaches that it is old and well known in the communication art to order products via the Internet using web-enabled mobile devices (see Kargman paragraph 47). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hymel would be motivated to automatically applied to a qualifying online purchase an electronic coupon stored in a user's mobile device, as taught by Leonard, where said mobile device would be web-enabled, as taught by Kargman in order to lure consumers to purchase products related to said coupons.

As per claim 9, Hymel fails to teach:

A method according to claim 7, wherein said coupon information represents a condition in which said benefit is applicable, and the benefit defined by said coupon information is applied to the sales contract only when said condition is satisfied upon the purchase of the given commodity. However, the same argument made in claim 8 is also made in claim 9.

As per claim 10, Hymel teaches:

A method according to claim 9, wherein said coupon information defines a plurality of benefits which are applicable under different conditions, and one of the benefits which is most advantageous for the user is applied to the sales contract among those benefits whose conditions are satisfied upon the purchase of the given commodity. However, Leonard teaches a system that search users computer in order to determine qualified stored coupons and based upon said searching said system



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automatically applied a qualifying coupon to a qualifying purchase (see paragraph 104).

Therefore, the same argument made in claim 8 is also made to claim 10.

As per claim 11, Hymel teaches:

A method of distributing an advertisement with a computer over a network, comprising the steps of:

managing coupon information which defines a discount amount upon purchase of a given commodity and advertisement information in association with said coupon information, and transmitting said advertisement information to a terminal which is connected via said network in response to a request from said terminal (see col 5, lines 35-55);

and, as immediate consequence of said transmitting storing said coupon information associated with said advertisement information transmitted to said terminal, in association with said terminal (see col 5, lines 35-55);

referring to said coupon information stored in association with said terminal and determining a price upon purchase of the given commodity in response to an application for the purchase of the given commodity from said terminal (see col 7, lines 15-50); and

Hymel fails to teach producing a sales contract for the given commodity with the determined price applied, and settling the purchase of the given commodity based on the sales contract. However, Leonard teaches a system where electronic coupons are stored in users' terminals and where said coupons are automatically applied to qualifying online purchase (see Leonard paragraph 105). Kargman teaches that it is old and well known in the communication art to order products via the Internet using web-

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enabled mobile devices (see Kargman paragraph 47). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hymel would be motivated to automatically applied to a qualifying online purchase an electronic coupon stored in a user's mobile device, as taught by Leonard, where said mobile device would be web-enabled, as taught by Kargman in order to lure consumers to purchase products related to said coupons.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Angles (US 5,933,811) in view of Leonard (US 2002/0046109) and further in view of Hymel (US 6,114,969).

As per claim 13, Angles teaches:

A method of browsing through an advertisement distributed over a network, comprising the steps of: acquiring first contents to which advertisement information is related, via said network;

acquiring the advertisement information related to said first contents, from a management server via said network (see col 16, lines 15-25);

storing an identifier transmitted from said management server (see col 16, lines 15-25);

transmitting said first contents and said advertisement information to the terminal which is connected via said network in response to a request from said terminal (see col 16, lines 10-45) and, as an immediate consequence of said transmitting, storing first reward associated with said advertisement information transmitted to said terminal, in association with said terminal (see col 16, lines 37-45);

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displaying said first contents and said advertisement information (see col 15, lines 20-35);

Angles fails to teach:

acquiring second contents including a list of commodities to which types of second coupon information defining a benefit upon the purchase of the commodities are related, via said network;

transmitting said types of second coupon information related to the list of commodities included in said second contents and said identifier to said coupon management server to acquire usable coupon information from said coupon management server and displaying said second contents and said usable coupon information. Hymel teaches a system where users are rewarded with coupons for reading advertisements (see Hymel col 5, lines 35-45). Leonard teaches a system that automatically applied a stored reward or coupon to a qualified online purchase (see paragraph 105). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Angles would reward users with electronic coupons for viewing advertisements by storing said coupons in said users' mobile devices, as taught by Hymel and would automatically applied said stored coupons to a qualifying product when said users perform a qualifying online purchase, as taught by Leonard in order that said coupons lure users to purchase products related to said coupons.

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***Response to Arguments***

8. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

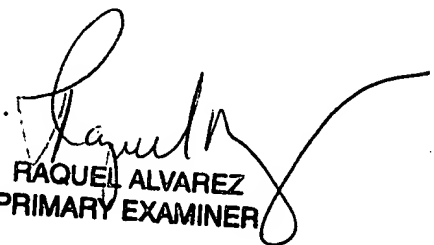
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
February 11, 2007

  
RAQUEL ALVAREZ  
PRIMARY EXAMINER